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10/664,473	09/17/2003	Carey E. Garibay	BEAS-01454US7	4342
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FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			EXAMINER AGWUMEZIE, CHARLES C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/664,473

Applicant(s)

GARIBAY ET AL.

Examiner

Charlie C. Agwumezie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18, 67-76 and 120-129 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 10-18, 67-76 AND 120-129 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/17/03; 03/11/05; 5/26/06, 1/17/07, 8/6/07
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Acknowledgment**

1. Applicants' election without traverse of group 1, claims 1-9, 10-18, 67-76, and 120-129, in the reply filed on August 6, 2007 is hereby acknowledged. Accordingly claims 1-9, 10-18, 67-76, and 120-129, have been examined.

### ***Response to Arguments***

2. Applicant's arguments filed October 13, 2006 have been fully considered but they are not persuasive.

With respect to **Claims 1, and 10**, Applicant argues that individually selectable licenses that can be upgraded or downgraded in a batch mode is not shown, suggested or given a motivation for in the cited prior art. That is the amended claim limitation "the multiple software licenses are individually selectable by the software user" is not disclosed or suggested by the references of record.

In response, Examiner respectfully disagrees and submits that Aldis et al discloses that "the multiple software licenses are individually selectable by the software user." Aldis teaches that digital licenses can be distributed in the form of license packs (batch). A license pack contains one or more digital licenses. A license pack contains a set that identify each individual license (see 0070). License download service is responsible for creating the license packs ... from the license database. ...License packs is a collection of one or more digital licenses (e.g., of several different kinds, perhaps) for use by the user (0080; 0147; see figs. 8-10 and 20-24). In order words user

create their own license packs. Accordingly Aldis et al does disclose the claim limitation "the multiple software licenses are individually selectable by the software user" as recited in independent claims 1, 10, and 87. Thus independent claims 1, and 10, are not patentable over Aldis et al. Alternatively Ross does disclose upgrade of software licenses in a batch mode (col. 4, lines 25-35)

With respect to **claims 2-9, 11-18, and 88-95**, these claims are withdrawn from further consideration pursuant to the election/restriction requirements.

With respect to **claims 19, 29 and 96**, withdrawn from further consideration.

With respect to **claims 20-28, 30-38, and 97-105**, withdrawn from further consideration.

With respect to **claims 39, 53, and 106**, withdrawn from further consideration.

As per **claims 40-52, 54-66, and 107-119**, withdrawn from further consideration.

With respect to **claims 67,77, and 120**, Applicant argues that the prior art does not describe or suggest downgrading a software license.

In response, Examiner respectfully disagrees with Applicant's characterization of Horstman. Horstmann does describe downgrade of software version as well as the associated licenses as described by these claims.

With respect to **claim 77**, withdrawn from further consideration.

As per **claims 68-76, and 121-129**, Applicant argues are dependent upon claims 67, and 120 and for that reason and because of the additional limitations are allowable.

In response, Examiner respectfully disagrees and submits that dependent claims 68-76, and 121-129 are neither allowable being dependent on claims 67, and 120 nor for their own recited limitations.

With respect to claims **78-86**, withdrawn from further consideration.

Thus for the reasons stated above and as shown in the rejections claims 1-9, 10-18, 67-76, and 120-129, are unpatentable over the references of record.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-8, 10-17, 39-41, 43-50, 52-55, 57-64, 66-94, 106-108, 110-117, and 119-129**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143.

As per **claim 1, 10, 67, and 120**, Aldis et al discloses a method comprising:  
maintaining digital records of software licenses, the digital records indicating rights associated with software licenses (0005; 0015; 0121).

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under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record (see abstract (see figs. 4 and 5; 0008; 0010; 0011; 0019; 0139; 0070; "license packs");

Aldis et al teaches that the digital license can be distributed in a license pack. A license pack is contains one or more digital licenses. Arguably a license pack is equivalent to the multiple software licenses in a batch mode as disclosed by present invention (see figs. 4 and 5; 0008; 0010; 0011; 0019; 0139; 0070; "license packs").

What Ross does not explicitly disclose is that the upgrade or down grade is done in a batch mode.

Ross et al discloses a method comprising: under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record (see abstract; col. 1, line 65-col. 2, line 10; col. 30-35; col. 4, lines 25-35; ...a batch of licenses may be anchor or upgrade licenses...)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method wherein under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record as taught by Ross et al in order to ensure availability of various product versions and user satisfaction.

As per **claim 2, 11, 68, and 121**, Aldis et al further discloses the method, wherein the upgrading or downgrading of rights is associated with the license key (0019; 0070).

As per **claims 3, 12, 69, and 122**, Aldis et al further discloses the method, wherein the digital record is accessed using a web application (see fig. 1; 0065; 0066 0147; "web browser or API").

As per **claims 4, 13, 70, and 123**, Aldis et al further discloses the method, wherein the web application uses role-based security (0005).

As per **claims 5, 14, 71, and 124**, Aldis et al further discloses the method, wherein digital records contain configuration information for the computer authorized to run the software (0010; 0072; "...hardware fingerprint of computer requesting activation code...").

As per **claims 6, 15, 72, and 125**, Aldis et al further discloses the method, wherein the digital records can be searched to find a specific digital record (0078; 0121; 0124; "...search and view licenses created...").

As per **claims 7, 16, 73, and 126**, Aldis et al further discloses the method, wherein the rights are associated with a license key (0019; 0070).

As per claims 8, 17, 74, and 127, Aldis et al further discloses the method, wherein configuration information for the computers running the software is stored in the digital record (0010; 0072).

As per claims 76, and 129, Aldis et al further discloses the method, wherein upgrading or downgrading of the version is done for multiple software licenses in a batch mode (0019; 0070; "license packs").

As per claim 128, Aldis et al further discloses the method, wherein the license version can also be upgraded (0103).

4. Claims 9, and 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143 as applied to claims 1, and 10, above, and further in view of Horstmann U.S. Patent No. 6,009,401

As per claims 9, and 18, both Aldis et al and Ross et al failed to explicitly disclose the method, wherein the license version is downgraded.

Horstmann discloses the method, wherein the license version is downgraded (fig. 1; col. 2, line 60-col. 3, line 15).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method,



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wherein the license version is downgraded as taught by Horstmann in order to ensure availability of various product versions and/or user satisfaction.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference cited to Biddle U.S. Patent Application Publication No. 2002/0107809 is a document considered relevant to the claimed invention.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Charlie Lion Agwumezie**  
**Patent Examiner**  
**Art Unit 3621**

**Acc**  
**October 5, 2007.**



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